

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF

DRYTSCHILO *et al.*

App'n. No.: 09/382,794

Filed: August 25, 1999

Confirmation No.: 5682

Group Art Unit: 1617

Examiner: WEBMAN, E.

Title: DELIVERY SYSTEM FOR THERAPY COMPRISING HOLLOW SEEDS,
PREFERABLY METAL, AND USE THEREOF

December 5, 2003

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REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the official action mailed October 6, 2003, in which a restriction requirement was issued. This response is timely filed, as it is being filed with a petition for a one-month extension of time and the requisite fee.

In the official action, the examiner groups the claims as follows:

Group I: claims 34-50, allegedly drawn to an intermediate composition classified in class 424, subclass 426; and

Group II: claims 51-70, allegedly drawn to a composition, classified in class 221, subclass 92.

The examiner also identifies multiple species and requires election of a single species of container shape, a single species of container (coated or uncoated), and a single species of coating polymer.

In response, the applicants elect Group I, claims 34-50, for prosecution on the merits.

With respect to the various species noted by the examiner, the applicants elect a cylindrical container without a coating. Because the applicants are electing a container without a coating, applicants respectfully submit that the issue of the particular species of coating

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polymer is moot. The applicants respectfully submit that claims 34-44 and 50 read on the elected species. These elections are made with traverse for at least the following reasons.

First and foremost, the applicants disagree with the examiner's assertion that the claims of Group I and the claims of Group II are related to one another as intermediate and final product. Claim 34, the independent claim of Group I, recites a container. Claim 51, the independent claim in Group II, recites the elements of the claim 34 container *verbatim* and also recites a storage cartridge having compartments that are constructed and arranged to house one or more of the containers. The container is not used to make the storage cartridge; therefore, the applicants fail to see how claims 34 and 51 could be construed as having an intermediate and final product relationship.

The applicants also disagree with the examiner's characterization of the Group I and II claims as being directed to compositions. As used in patent law, the word "composition" has the meaning given to it in 35 U.S.C. § 101 ("Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter..."), *i.e.*, a chemical composition. However, the applicants are claiming, respectively, a container and a container in combination with a storage cartridge. These items are conventionally classified as apparatuses or, to use the terminology of 35 U.S.C. § 101, as "manufactures." The applicants note that the third paragraph of MPEP § 806.04(b), to which the examiner refers, specifically relates to chemical "species of carbon compounds."

Contrary to the examiner's assertions, the applicants submit that claim 51 is properly analyzed as a combination claim in which the container of claim 34 is recited as a subcombination or element. See, for example, MPEP § 806.05(a), which states that "a combination is an organization of which a subcombination or element is a part." Furthermore, the applicants submit that the relationship between claims 34 and 51 is clearly the relationship described in MPEP § 806.05(c)(II) (AB_{sp}/B_{sp}), in which a specific combination of features that is the subject of one independent claim (B_{sp} ; claim 34) is recited with the same specificity as a subcombination in the other independent claim (forming AB_{sp} ; claim 51). Therefore, according to MPEP § 806.05(c), restriction between the two groups of claims is improper.

However, if the examiner insists on applying the guidelines set forth in MPEP § 806.04(b), then the applicants submit that the examiner should apply all of the guidelines in that section. For the sake of argument, the applicants will treat those guidelines here.

Assuming, *arguendo*, that the Group I and Group II claims represent related species belonging to some as-yet unidentified genus (an assertion with which the applicants do not agree), the applicants note the guidelines in the first paragraph of § 806.04(b):

Where the inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined restriction must be determined by both the process applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP § 806.05 - § 806.05(i). If restriction is improper under either practice, it should not be required. (Emphasis added.)

Thus, according to MPEP § 806.04(b), the examiner must also analyze the claims under the guidelines set forth in MPEP § 806.05 - § 806.05(i), which the examiner has failed to do in the present official action. For at least that reason, the restriction requirement is improper and should be withdrawn. Moreover, as the applicants explained above, the claims are not restrictable under a proper combination-subcombination analysis.

Finally, the applicants respectfully submit that the examiner's classification of the claims is inappropriate, and respectfully request that it be reconsidered. For example, the examiner asserts that claims 51-70 should be classified in class 221, subclass 92. However, the class definition of class 221, as given in the Patent Office *Manual of Classification*, requires article dispensing structure. However, claim 51 does not recite any such dispensing structure. As claimed, the storage cartridge of claim 51 is a static structure having a number of compartments. Therefore, the most relevant portion of the class 221 definition would appear to be as follows:

(2) Supply Source Container or Holder Structure (Static Structures)

Devices in which the configuration or internal structure of the container or holder for the articles to be dispensed is specialized to the problem of the separation of articles being dealt out from a source, are considered to be dispensers and are included in this class. Examples of such structures included in this class with the limits thereof are:

(a) Internal structure of supply receptacles, as means at or near the outlet for retarding a succeeding article while the leading article is removed or for imparting a transverse article segregating motion to the articles.

(b) Trap chamber structure, that is, supply container configuration which creates identifiable trap means to isolate the leading article from the remainder of the articles for ease of

removal. It is usually characterized by abrupt change of direction of the path of movement of the articles to hold back otherwise freely sliding or rolling succeeding articles in contact with the article or articles available for removal at one operation.

(c) Container, chute or rack structures of nonrectilinear configuration may be included in this class under certain circumstances such as (1) when the curve or angular turn in the container, chute or rack is such as to change the nature of a stack or arrangement of articles (as from end to end to side by side, or from a double row to a single row) so that article removal from the ultimate arrangement is easier than it would otherwise have been or, (2) when the curve or angular turn is specifically modified at or near the egress point to present an article or articles in such a way that they are relatively easily removable, as by changing the relative bearing on such article or articles of the succeeding articles on such article or articles. In this connection it is noted that it is common for article supporting rack structure to be curved or angular for purposes of space conservation or for controlling the direction or disposition of the inlet and/or outlet, and it is not intended that such structures should be classified in this class. It is also recognized that as a rack structure approaches a horizontal disposition the relative ease of removing articles increases, but this is considered to be a mere incident to the rack problem of space conservation and directional disposition and not to warrant classification in this dispensing class.

Clearly, none of those types of structures are recited in claim 51, or in any of the claims that depend from it. Therefore, the applicants respectfully submit that the examiner's classification of claim 51, and the claims that depend from it, is inappropriate.

Additionally, the applicants respectfully submit that examining all of the claims would not pose a burden. MPEP § 803 states that "if the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." The applicants submit that this policy should apply to the present application in order to avoid duplicative examination and any further delays.


For all of the reasons given above, the applicants respectfully request that the restriction requirement be withdrawn.

CONCLUSION

As a final note, the applicants are dismayed by the examiner's decision not to employ the telephone restriction practice advocated in the MPEP, a practice which might have expedited the prosecution of this application, which has already been pending for over four years. If any issues arise relating to this response, the examiner is strongly urged to contact the undersigned via telephone, so that those issues can be resolved immediately.

Respectfully submitted,

Pillsbury Winthrop LLP

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